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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,647	12/19/2001	Thomas J. Pinnavaia	MSU 4.1-568	9416

7590  
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10/08/2003

EXAMINER

SAMPEE, DAVID R

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/08/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,647

Applicant(s)

PINNAVAIA ET AL.

Examiner

David Sample

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 30-42, 53-55, 57-63, 65-71, 77, 78 and 81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20-29, 43-52, 56, 64, 72-76, 79, 80, 82 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of claims 1-12, 20-29, 43-52, 56, 64, 72-76, 79, 80, 82, and 83 in Paper No. 6 is acknowledged.

Claims 13-19, 30-42, 53-55, 57-63, 65-71, 77, 78 and 81 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 11, 23 47, 48 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu et al. (in *J. Am. Chem. Soc.*, vol. 122, pages 8791-8792, published 08/24/2000).

Liu et al. discloses a mesoporous aluminosilicate material having the claimed properties. See page 8791, second column first full paragraph Table 1, page 8792.

The present application is a CIP of application serial no. 09/792,017. The present application is entitled to the priority of the '017 application if the present claims have adequate written description support in the '017 application. Instant claims 1, 3-5, 11, 23 47, 48, 76 are not supported by the '017 application since the '017 application fails to disclose the concept that

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the aluminosilicate may not have an x-ray diffraction peak between 2 and 100 nm. Therefore, claims 1, 3-5, 11, 23 47, 48, 76 of the instant application are not entitled to the priority of the '017 application and the reference qualifies as prior art under 35 U.S.C. § 102(b).

Claims 1, 3, 5, 23, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Shu et al. (US Patent No. 5,232,675).

Shu et al. discloses a zeolite aluminosilicate composition which retains 85.1% of its crystallinity after steaming for 4 hours in 100% steam at 800°C. See Table 4, lines 12-17. In zeolites, the crystalline framework encompasses micropores. If the crystallinity decreases from 100 to 85.1% (as the zeolite does in Example 15), then the micropores of the zeolite must inherently decrease a corresponding amount. Accordingly, the claimed steam stability is assumed to be inherent to the material of Shu et al. See MPEP 2112.

It is noted that Shu employs an atmosphere of 100% steam whereas the present claims refer to a treatment in 20% steam. However, an increased steam content would result in a greater decrease in porosity. Thus, steaming at 100% steam would result in a larger decrease in porosity than steaming at 20% steam. Since the material of Shu et al. exhibits the claimed decrease in porosity at 100% steam, it is assumed that it would inherently possess the same or better steam stability at the claimed atmosphere of 20%.

The zeolite in Example 15 was prepared from the zeolite of Example 11, which was formed from zeolite made in Example 4. See col. 7, line 68, col. 9, lines 20-25 and col. 15, line 63. The zeolite of Example 4 has a  $\text{SiO}_2/\text{Al}_2\text{O}_3$  ratio of 39.3 (i.e., a Si/Al ratio of 19.65).

Zeolites inherently possess  $\text{AlO}_4$  and  $\text{SiO}_4$  linked tetrahedrons.

### ***Double Patenting***

Claims 2-5, 25, 26, and 43-47 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2-5, 25, 26, and 43-47 of copending Application No.

09/797,017. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 3-12, 20-24, 27-29, 48-52, 56, 64, 72-76, 79, 80, 82, and 83 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11, 12, 20-26, 29, 43-47 of copending Application No. 09/797,017 ('717). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '717 claims describe a subgenus that anticipates the presently claimed genus, and anticipation is the ultimate in obviousness.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

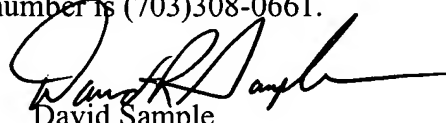
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (703)308-3825. The examiner can normally be reached on Monday to Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703)308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

  
David Sample  
Primary Examiner  
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